REMARKS

Introduction

Claims 51-56, 58, 60-81, 83, 85-106, 108, and 110-125 are pending in this case.

The Examiner rejected claims 51, 52, 54-56, 58, 60-77, 79-81, 83, 85-102, 104-106, 108, and 110-125 under 35 U.S.C. §103(a) as being unpatentable over Shoff et al. U.S. Patent No. 6,240,555 (hereinafter "Shoff") in view of Matthews, III et al U.S. Patent No. 6,025,837 (hereinafter "Matthews"). The Examiner rejected claims 53, 78, and 103 under 35 U.S.C. §103(a) as being unpatentable over Shoff in view of Matthews and Davis U.S. Patent No. 5,559,548 (hereinafter "Davis").

The Examiner's rejections are respectfully traversed.

Applicants' Reply to the Examiner's Rejections

The Examiner rejected claims 51, 52, 54-56, 58, 60-77, 79-81, 83, 85-102, 104-106, 108, and 110-125 under 35 U.S.C. §103(a) as being unpatentable over Shoff in view of Matthews. The Examiner rejected claims 53, 78, and 103 under 35 U.S.C. §103(a) as being unpatentable over Shoff in view of Matthews and Davis.

Applicants submit independent claims 51, 76, and 101 are patentable over Shoff and Matthews because 1) even the

proposed combination of the references fails to show or suggest all of applicants' claimed features and 2) the Examiner has failed to provide the necessary motivation or suggestion to combine the references.

Applicants' system, method, and machine-readable media of independent claims 51, 76 and 101 are directed to an approach in which an interactive television program guide has "local memory" and "remote memory." The local memory is configured "to store program guide data for use by the interactive television program guide." The remote memory is configured "to store supplemental data for access by the interactive television program guide." The supplemental content, which may be stored in the local memory, may include detailed descriptions, biographies, video and audio clips, trivia and so forth (see, e.g., applicants' specification at page 19, lines 17-30).

Further, "when a user's actions in navigating through the interactive television program guide are indicative of a potential upcoming need for a given portion of supplemental data, the system automatically supplies the given portion of the supplemental data from the remote memory to the interactive television program guide in advance of the upcoming need" (independent claims 51, 76 and 101). For example, in one embodiment of applicants' invention, the user's actions in navigating through the interactive

television program guide include browsing through programs in a program listing grid. In response, the program guide transfers supplemental data for all programs displayed on the monitor from the remote memory to the local memory (see applicants' specification, FIG. 4; page 21, lines 1-19).

The Examiner admits that Shoff does not disclose applicants' claimed feature of "when a user's actions in navigating through the interactive television program guide are indicative of a potential upcoming need for a given portion of supplemental data, the system automatically supplies the given portion of the supplemental data from the remote memory to the interactive television program guide in advance of the upcoming need" (Office Action, page 3, ¶ 2). However, the Examiner contends that this feature is disclosed by Matthews.

Contrary to the Examiner's contention, applicants submit Matthews merely describes a system which downloads data records for upcoming programs on a periodic basis or in response to viewer requests, and which pre-caches supplemental information about certain shows before they air based on predictive viewing tendencies, or as part of a promotional data broadcast (Matthews, col. 9, line 49 to col. 10, lines 13). Nowhere does Matthews show or suggest that the downloading of its data records or the pre-caching of its supplemental information occurs "<u>when a user's actions in</u>

navigating through the interactive television program guide are indicative of a potential upcoming need for a given portion of supplemental data," as required by applicants' claims.

At most, Matthews describes a system that pre-caches supplemental information based on "predictive viewing tendencies." Applicants submit, however, that Matthews' method of pre-caching based on predictive viewing tendencies does not anticipate applicants' claimed approach of supplying supplemental data in advance "when a user's actions in navigating through the interactive television program guide" are indicative of a potential upcoming need for supplemental data. In particular, nowhere in Matthews is the phrase "predictive viewing tendencies" associated with a user's actions in navigating through an interactive television program guide. Instead, the phrase merely conveys in a vague and unclear manner some method of predicting what the viewer will tend to view on television. This should be contrasted with applicants' clear recitation of an approach in which "a user's actions in navigating through the interactive television program guide" indicate to the system a potential upcoming need for supplemental data.

Applicants further submit that the Office Action failed to provide sufficient motivation for even combining Shoff with Matthews. In re Rouffet, 149 F.3d 1350, 1355 (Fed.

Cir. 1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"); see also MPEP §§ 2142 and 2143.01. It is well-settled that an Office Action can "satisfy this burden only by showing some objective teaching ... that would lead [one of ordinary skill in the art] to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

However, instead of providing a proper motivation to combine Shoff with Matthews, the Office Action merely relies on an insufficiently broad and conclusory statement:

> Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shoff with Matthew [sic] so to improve the access time of additional information in which additional information is pre-cached at local memory of the receiver.
>
> (Office Action, page 3, ¶ 3)

Such "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'" of a motivation to combine. In addition, relying solely on applicants' "disclosure as a blueprint for piecing together the prior art to defeat patentability" is insufficient as a matter of law. In re Kotzab, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999); see also In re Lee, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) ("The factual inquiry of whether to combine references must be thorough and searching"); MPEP § 2143.

Accordingly, for at least the foregoing reasons, applicants submit independent claims 51, 76 and 101 are patentable over Shoff and Matthews because 1) the proposed combination of the references fails to show or suggest all of applicants' claimed features and 2) the Examiner has failed to provide the necessary motivation or suggestion to combine the references.

Applicants respectfully submit the foregoing demonstrates that independent claims 51, 76, and 101 are patentable. Accordingly, applicants submit claims 52-56, 58, 60-75, 77-81, 83, 85-100, 102-106, 108, and 110-125, which depend from claims 51, 76, and 101, are also patentable.

Conclusion

Applicants submit this application is now in condition for allowance. Accordingly, prompt consideration and allowance of this application are respectfully requested.

Respectfully submitted,

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